



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,791	11/13/2000	Srikrishna Talluri	BUO 0101 PUS	7186

22045 7590 03/23/2004

BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER

TRAN, QUOC A

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary

Application No.

09/711,791

Applicant(s)

TALLURI, SRIKRISHNA

Examiner

Quoc A. Tran

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2 and 4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to application filed **11/13/2000**.
2. Claims 1-25 are currently pending in this application. Claims 1, 13 and 25 are independent claims.
3. If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-6, 9, 13-17, 20-21, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated over Ebrahim, US Patent No. 5,970,505 issued Oct. 19, 1999 filed Mar. 31, 1997(hereinafter '505).**

In regard to independent claim 13, '505 teaches, collaboration among multiple sets of authors of related documentation books in a documentation set wherein each book in a set written by multiple authors constitutes a single domain, and multiple of these domains constitute the documentation set such that each domain may be independently administered, be geographically dispersed, be on different computer and operating systems, and be connected by either a corporate intranet, or the public internet, networking infrastructure, see '505 col.1, lines 61-67 through col. 2, lines 1-3; compare with claim 13 *"transmitting identification of reference material cited by the author in the manuscript to the communications network from the first communications device"*,

'505 also teaches, method for linking data in a document set including a plurality of books written by different groups of authors. The first step involves an author of a first book tagging an information unit (iunit) in that book with a tag that provides information about the iunit, including a semantic attribute and a unique identifier. The author then exports the tag to a tag repository that is accessible to all groups of authors, see '505

col. 2, lines 8-12; compare with claim 13 *"receiving the identification of the reference material cited by the author at the database; associating a distinctive key with the reference material cited by the author; storing at the database a copy of the reference material cited by the author and the associated distinctive key"*,

'505 also teaches, An author of a second book can then access the tag repository and select a tag whose corresponding information they would like to import into the second book. The semantic information is preferably a meaningful description provided by the author of the first book that is viewable and searchable in the tag repository to enable an iunit of a desired semantic type to be selected for importation into the second book, see '505 col. 2, lines 13-15; compare with claim 13 *"transmitting a request for a copy of the reference material from the audience to the database using the second communications device; and transmitting a copy of the reference material from the database to the audience in response to the database receiving the request for a copy of the reference material from the audience"*.

In regard to dependent claim 14, '505 teaches, The tag repository can also be distributed across a plurality of networked nodes running a filesystem, see '505 col.2, lines 61-67; compare with claim 14 *"transmitting the distinctive key associated with the copy of the reference material from the database to the author "*.

In regard to dependent claim 15, '505 teaches, An author of a second book can then access the tag repository and select a tag whose corresponding information they would like to import into the second book. The semantic information is preferably a meaningful description provided by the author of the first book that is viewable and

searchable in the tag repository to enable an iunit of a desired semantic type to be selected for importation into the second book, see '505 col. 2, lines 13-15; compare with claim 15 "*citing the distinctive key associated with the copy of the reference material in the manuscript; and obtaining the distinctive key from the manuscript by the audience; wherein transmitting a request for a copy of the reference material from the audience to the database includes transmitting a request having the distinctive key to the database*".

In regard to dependent claim 16, '505 teaches, When invoked, the tagfinder shows the contents of the docset hierarchically by accessing each Docdomain.sub.--URL and its constituents. This mode of operation can be achieved with conventional Web browsers, which display documents comprising many subdocuments by automatically retrieving each subdocument pointed to by a parent document, see '505 col. 10, lines 3-9; compare with claim 16 "*the reference material cited by the author in the manuscript is a website*".

In regard to dependent claim 17, '505 teaches, the tag repository can comprise a single, global tag repository stored on a single computer and accessed through network protocols such as HTTP (hypertext transfer protocol), in which case the access could be from an HTML-based browse. In another embodiment the tag repository can be distributed across multiple computers that permit access to the tags through a variety of means, such as Web browsers, remote procedure calls (RPC) and client-server engines, see '505 col. 10, lines 3-9; compare with claim 17 "*receiving a copy of the website at the database from the communications network for storage; wherein transmitting a copy of the reference material from the database to the audience in*

Art Unit: 2176

response to the database receiving the request for a copy of the reference material from the audience includes transmitting a copy of the website to the audience."

In regard to dependent claim 20, '505 teaches, group/book/docdomain ("atm" is an abbreviation for asynchronous transfer mode). Table 1 represents the contents of the file, "foo.bar", in a generic markup language that is similar to GML.TM.. The present invention is equally applicable to other types of document preparation systems, including WYSIWYG word processors, and is independent of any specific file format (e.g., the file may be an HTML file or any other type file), see '505 col. 3, lines 54-61; compare with claim 20 *"the reference material cited by the author in the manuscript is stored as a digital file "*.

In regard to dependent claim 21, '505 teaches, the tag repository can comprise a single, global tag repository stored on a single computer and accessed through network protocols such as HTTP (hypertext transfer protocol), in which case the access could be from an HTML-based browser. In another embodiment the tag repository can be distributed across multiple computers that permit access to the tags through a variety of means, such as Web browsers, remote procedure calls (RPC) and client-server engines, see '505 col. 2, lines 34-45; compare with claim 21 *"receiving a copy of the digital file at the database from the communications network for storage; wherein transmitting a copy of the reference material from the database to the audience in response to the database receiving the request for a copy of the reference material from the audience includes transmitting a copy of the digital file to the audience "*.

In regard to dependent claim 24, '505 teaches, each domain may be independently administered, be geographically dispersed, be on different computer and operating systems, and be connected by either a corporate intranet, or the public internet, networking infrastructure), see '505 col. 1, lines 66-67 through col. 2, lines 1-3; compare with claim 24 *"the communications network is the Internet"*.

In regard to Independent claim 1, is directed to a system for performing the method of claim 13, and is similarly rejected under the same rationale.

In regard to dependent claim 2, is directed to a system for performing the method of claim 24, and is similarly rejected under the same rationale.

In regard to dependent claim 3, is directed to a system for performing the method of claim 14, and is similarly rejected under the same rationale.

In regard to dependent claim 4, is directed to a system for performing the method of claim 15, and is similarly rejected under the same rationale.

In regard to dependent claim 5, is directed to a system for performing the method of claim 16, and is similarly rejected under the same rationale.

In regard to dependent claim 6, is directed to a system for performing the method of claim 17, and is similarly rejected under the same rationale.

In regard to dependent claim 9, is directed to a system for performing the method of claim 20, and is similarly rejected under the same rationale.

In regard to independent claim 25, is directed to a system for performing the method of claim 13, and is similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-8, 10-12, 18-19, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebrahim, US Patent No. 5,970,505 issued Oct. 19, 1999 filed Mar. 31, 1997(hereinafter '505), in view of Clark et al. Pub. No.: US 2002/0152215 A1 Pub. Date. Oct. 17, 2002 filed Sep. 26, 2001 provisional No. 60/243,259 filed Oct. 25, 2000 (hereinafter '259).

In regard to dependent claims 18, and 19, '505 *does not explicitly teaches*, *"the reference material cited by the author in the manuscript is an email"*, *"receiving a copy of the e-mail at the database from the communications network for storage; wherein transmitting a copy of the reference material from the database to the audience in response to the database receiving the request for a copy of the reference material from the audience includes transmitting a copy of the e-mail to the audience"* however '259 teaches, As shown in FIG. 17, the retailer 206 transmits fulfillment information 324, such as a URL (Universal Resource Locator) link, to the consumer 208 for each purchased eBook. For example, the retailer 206 may include the URL in an e-mail message sent to the consumer 208 or may include the

Art Unit: 2176

URL in a dynamically constructed web-page that lists items requested by a consumer 208, see '259 page 5, paragraph [0071].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teaching of '505 with '259. One of the ordinary skill in the art would have been motivated to modify this combination to utilize the e-mail feature of web-base (server/clients) for archiving reference material in a bibliography of a manuscript using a communications network, because, ***Much like an ordinary printed book, electronic books ("eBooks") can be used to present text and pictures to readers. Instead of ink and paper, however, an electronic book is a collection of digital data that software, known as an electronic book reader, can interpret and present on a display. A variety of devices run electronic book reader software such as personal computers, handheld personal digital assistants (PDAs), cellular phones with displays, and so forth. Electronic books can offer a variety of features not traditionally associated with print books. For example, instead of text and pictures, an electronic book may also store data used to present sound such as music and speech. Further, instead of still pictures, an electronic book can also present animated images. Additionally, by transmitting eBook data over a computer network, eBooks can be delivered to remote locations almost instantaneously***, see '259 page 1, paragraph [0003] through [0004].

In regard to dependent claim 22, '505 ***does not explicitly teaches, "the reference material cited by the author in the manuscript is a paper book"***, however '259 teaches, A server 210 may provide a web-site that enables consumers and/or

Art Unit: 2176

publishers to request electronic books or "print-on-demand" hard copies of a title, see '259 page 5, paragraph [0069].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teaching of '505 with '259. One of the ordinary skill in the art would have been motivated to modify this combination to offer to audiences the choices of reference material cited by the author in the manuscript is a paper book or electronic files, because, ***Much like an ordinary printed book, electronic books ("eBooks") can be used to present text and pictures to readers. Instead of ink and paper, however, an electronic book is a collection of digital data that software, known as an electronic book reader, can interpret and present on a display. A variety of devices run electronic book reader software such as personal computers, handheld personal digital assistants (PDAs), cellular phones with displays, and so forth. Electronic books can offer a variety of features not traditionally associated with print books. For example, instead of text and pictures, an electronic book may also store data used to present sound such as music and speech. Further, instead of still pictures, an electronic book can also present animated images. Additionally, by transmitting eBook data over a computer network, eBooks can be delivered to remote locations almost instantaneously,*** see '259 page 1, paragraph [0003] through [0004].

In regard to dependent claim 23, '505 ***does not explicitly teaches, "receiving an electronic scanned copy of the paper book at the database from the author via the communications network for storage; wherein transmitting a copy***

Art Unit: 2176

of the reference material from the database to the audience in response to the database receiving the request for a copy of the reference material from the audience includes transmitting a copy of the electronic scanned copy of the paper book to the audience", however '259 teaches, the user interface also enables a publisher to select a method of delivering content 278 to the server. For example, a publisher can select file upload over the Internet, physical delivery of a computer readable medium (e.g., a CD-ROM or floppy), or a hard copy for scanning or other conversion into electronic form. The publisher can similarly specify 279 a mechanism for uploading a book cover image, see '259 page 3, paragraph [0036].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teaching of '505 with '259. One of the ordinary skill in the art would have been motivated to modify this combination to offer to audiences the choices of reference material cited by the author in the manuscript is a paper book or electronic files, because, *Much like an ordinary printed book, electronic books ("eBooks") can be used to present text and pictures to readers. Instead of ink and paper, however, an electronic book is a collection of digital data that software, known as an electronic book reader, can interpret and present on a display. A variety of devices run electronic book reader software such as personal computers, handheld personal digital assistants (PDAs), cellular phones with displays, and so forth. Electronic books can offer a variety of features not traditionally associated with print books. For example, instead of text and pictures, an electronic book may also store data used to present sound such as*

music and speech. Further, instead of still pictures, an electronic book can also present animated images. Additionally, by transmitting eBook data over a computer network, eBooks can be delivered to remote locations almost instantaneously, see '259 page 1, paragraph [0003] through [0004].

In regard to dependent claim 7, is directed to a system for performing the method of claim 18, and is similarly rejected under the same rationale.

In regard to dependent claim 8, and 10 are directed to a system for performing the method of claim 19, and is similarly rejected under the same rationale.

In regard to dependent claim 11, is directed to a system for performing the method of claim 22, and is similarly rejected under the same rationale.

In regard to dependent claim 12, is directed to a system for performing the method of claim 23, and is similarly rejected under the same rationale.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cohen et al. U.S. Patent No. 5,367,621 issued 11/22/1994 filed 09/06/1991

Hobbs U.S. Patent No. 5,987,454 issued 11/16/1999 filed 06/09/1997

Herz U.S. Patent No. 6,460,036 B1 issued 10/01/2002 filed 12/05/1997

Clark et al. U.S. Pub No. 2002/0152215 A1 issued 10/17/2002 filed 09/26/2001

Clark et al. Related U.S. Application provisional No. 60/243,259 filed 10/25/2000

Art Unit: 2176

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-8781. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A. Tran

Patent Examiner

Technology Center 2176

March 3, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER